REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-14, 22-27, 31-32 and 34-38 are presently active in this case. The present Amendment amends Claims 1-4, 6-8, 14, 22, 25, 31-32 and 34 and cancels Claims 28-30 and 33.

The outstanding Office Action rejected Claims 1, 7, 8, 22 and 25 under 35 U.S.C. §112, second paragraph, as indefinite. Claims 1-14 and 22-38 were rejected under 35 U.S.C. §102(e) as anticipated by Hikawa (U.S. Patent No. 6,678,065). Claims 1-14 and 22-28 were rejected under 35 U.S.C. §102(e) as anticipated by Mori (U.S. Patent No. 6,084,685). Claims 29-38 were rejected under 35 U.S.C. §103(a) as unpatentable over Mori in view of Hikawa.

In response to the rejection under 35 U.S.C. §112, second paragraph, independent Claim 1 is amended to correct the noted informalities. In particular, independent Claim 1 is amended to delete "in response to a command that is accepted" and "carrying out" is replaced by "performing." Independent Claims 7, 8, 14, 22 and 25 are amended in accordance with the changes to independent Claim 1. In view of amended Claims 1, 8, 14, 22 and 25, it is believed that all pending claims are definite and no further rejection on that basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually acceptable language.

To correct minor informalities, Claims 1-4, 6-8, 14, 22, 25, 31-32 and 34 are amended. Since the changes to Claims 1-4, 6-8, 14, 22, 25, 31-32 and 34 are only formal in nature, they are not believed to raise any question on new matter.

Addressing now the rejection of Claims 1-14 and 22-28 under 35 U.S.C. §102(e) over Mori, that rejection is traversed by the present response.

Initially, Applicant notes that independent Claim 1 is amended to recite features of dependent Claims 28-30 and 33. In particular, independent Claim 1 is amended to recite "buffering the image data temporarily in a buffer before said storing; causing a DMA transfer request when a storage capacity of said buffer occupied by the image data reaches a predetermined preset value; and transferring the image data within said buffer by a DMA transfer based on the DMA transfer request." Independent Claims 7, 8, 14, 22 and 25 are amended to recite similar features regarding a DMA transfer and a predetermined preset value. These features find non-limiting support in Claim 14 as originally filed and in Applicant's Specification from page 38, line 2 to page 39, line 8. Accordingly, dependent Claims 28-30 and 33 are cancelled.

In response to the rejection of Claims 1-14 and 22-38 under 35 U.S.C. §102(e) over Hikawa, Applicant respectfully requests reconsideration of this rejection and traverses the rejections, as discussed next.

Briefly recapitulating, Applicant's Claim 1 relates to an image processing method including performing a process of an image reading function, an image recording function, an image copying function and an image communicating function in parallel; storing a file of the image data independently of the processes of the image reading function, the image recording function, the image copying function and the image communicating function; buffering the image data temporarily in a buffer before the storing; causing a DMA transfer request when a storage capacity of the buffer occupied by the image data reaches a predetermined preset value; and transferring the image data within the buffer by a DMA transfer based on the DMA transfer request. As explained in Applicant's Specification from page 4, line 15 to page 5, line 16, Applicant's invention improves upon background image processing methods, since image data can be electronically filed while carrying out other image processing tasks.

Turning now to the applied references, Hikawa discloses an image forming apparatus, wherein a management table organizes the required amount of resources for jobs that have to be executed. However, Hikawa fails to disclose the claimed transferring the image data ***within said buffer*** by a ***DMA transfer***, and the claimed causing a DMA request when a storage capacity of said buffer reaches ***a predetermined preset value***, as discussed next.

The outstanding Office Action states that "Hikawa teaches that the image processing system has a DMA controller" and that "it is inherent that there must be a DMA transfer bus line used for transferring the image data to be stored in either DRAM or/and HDD."[1] Applicant respectfully submits that Hikawa only broadly indicates a "DMA transfer rate" at a single position of the disclosure.[2] Merely because Hikawa recites a "DMA transfer rate," it is impossible to infer that image data is transferred ***within a buffer*** by DMA transfer. The one vague reference in Hikawa is clearly insufficient to show that Hikawa's DMA transfer rate inherently teaches the claimed transferring of the image data ***within said buffer*** by a DMA transfer, because it fails to show "that the allegedly inherent characteristic ***necessarily*** flows from the teachings of the applied prior art."[3] The outstanding Office Action even states that "data transfer [is performed] directly between memory and a hard disk,"[4] which is not a transfer within a buffer, as claimed.

Further, Applicant respectfully submits that Hikawa also does neither teach nor suggest Applicant's claimed causing a DMA transfer request when a storage capacity of the buffer occupied by the image data reaches a ***predetermined preset value***. Hikawa discloses

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[1] See the outstanding Office Action at page 9, lines 13-18.
[2] See Hikawa at column 6, line 44
[3] See MPEP 2112 (emphasis in original) (citation omitted). See also same section stating that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic," (emphasis in original). See also In re Robertson, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) ("[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill,'" citing Continental Can Co. v. Monsanto Co., 948 F2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991); and "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient," Id. at 1269 (citation omitted)).
[4] See the outstanding Office Action at page 9, lines 15-16.

that passing image data among the HDD and the memory is repeatedly performed.[5] According to Hikawa, if a minimum required amount of resources cannot be ensured, the execution of that job must be disabled.[6] Disabling a job because of insufficient resources, as taught by Hikawa, ***is not*** the causing a DMA transfer request when a storage capacity of the ***buffer*** occupied by the image data reaches a ***predetermined preset value***, as claimed.

Therefore, Hikawa fails to teach or suggest every feature recited in Applicant's claims, so that Claims 1-14, 22-27, 31-32 and 34-38 are believed to be patentably distinct over the applied references. Accordingly, Applicant respectfully traverses, and requests reconsideration of, the rejection based on Hikawa.[7]

In response to the rejection of Claims 29-38 under 35 U.S.C. §103(a) over Mori in view of Hikawa, Mori does not overcome the above-noted deficiencies in Hikawa, and thus both references Mori and Hikawa do no teach all the features of Applicant's independent Claims 1, 7, 8, 14, 22 and 25 as argued above. Thereby, the rejection under 35 U.S.C. §103(a) is believed to be overcome. Accordingly, Applicant respectfully requests reconsideration of the rejection.

The present amendment is submitted in accordance with the provisions of 37 C.F.R. §1.116, which after Final Rejection permits entry of amendments placing the claims in better form for consideration on appeal. As the present amendment is believed to overcome outstanding rejections under 35 U.S.C. §112, second paragraph, 35 U.S.C. §102(e) and 35 U.S.C. §103(a), the present Amendment places the application in better form for consideration on appeal. In addition, the present amendment is not believed to raise new issues because the changes to independent Claims 1, 7, 8, 14, 22 and 25 merely recite

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[5] See Hikawa at column 5, lines 17-27 and in corresponding Figure 2.
[6] See Hikawa at column 6, lines 27-36.
[7] See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

limitations previously introduced in Claims 28-30 and 33, and the changes to Claims 1-4, 6-8, 14, 22, 25, 31-32 and 34 are of a minor nature. It is therefore respectfully requested that 37 C.F.R. §1.116 be liberally construed, and that the present amendment be entered.

Consequently, in view of the present Amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-14 and 22-27, 31-32 and 34-38 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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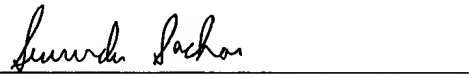

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